

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:

SAITO et al.

Application No. 10/577,876

Art Unit: Unassigned

Filed: April 28, 2006

Examiner: Unassigned

For: **METHOD FOR GLOSSING SOLID
SURFACE AND FILM-FORMING
COATING LIQUID**

RENEWED PETITION UNDER 37 CFR 1.47(a)

Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Dear Sir:

The following remarks are responsive to the points raised by the Decision on the Petition under 37 CFR § 1.47(a) dated February 12, 2007 (hereinafter, "Decision"). In view of the following remarks, reconsideration is respectfully requested.

According to the Decision, a petition under 37 CFR § 1.47(a) requires factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort ("requirement (2)"). According to the Decision, requirement (2) has not been satisfied on two grounds. First, the Decision alleges that the petitioners have not established that Mr. Makino refused to sign the Declaration after having been presented with a complete copy of the application papers for the instant application; the Decision further alleges that neither the Declaration of Mr. Ogura nor the e-mail evidence of record refers to a copy of the application as having been presented to Mr. Makino. Second, the Decision alleges that the evidence of record does not clearly establish that Mr. Makino is specifically refusing to sign the Declaration as opposed to one or more of the other documents presented to him, including a Preliminary Amendment, an Assignment pertinent to the U.S., and an Assignment pertinent to Canada.

As set out in more detail below, the evidence currently of record clearly satisfies the requirements of 37 C.F.R. § 1.47(a). First, the evidence of record clearly shows that Mr. Makino was presented with a complete copy of the application papers for the instant application. Second, the evidence of record clearly shows that Mr. Makino specifically refused to sign *all* of the documents, including the Declaration.

A. The evidence of record shows that Mr. Makino was presented with a complete copy of the application papers for the instant application.

First, Mr. Ogura's Declaration clearly evidences that Mr. Makino was presented with a complete copy of the application papers for the instant application, U.S. Application No. 10/577,876. Mr. Ogura's Declaration begins by clearly and unambiguously identifying the instant application:

An international application based on and claiming priority to the Japanese application and which designated the United States and Canada was filed under the Patent Cooperation Treaty on October 20, 2004 as Application No. PCT/JP2004/015529 (the PCT application). The PCT application entered the national phase in the United States on April 28, 2006 and was accorded Application No. 10/577,876 ('876 application) (Mr. Ogura's Declaration, paragraph 3).

Mr. Ogura's Declaration also clearly and unambiguously identifies the Declaration:

This Declaration pertains to the '876 United States patent application (Mr. Ogura's Declaration, paragraph 3).

Paragraph 6 of Mr. Ogura's Declaration further explains that he sent a copy of the Declaration and patent application referred to in Paragraph 3 to Mr. Makino:

On May 25, 2006, I sent Mr. Makino another e-mail, requesting him to place his signature on the documents, and attaching to the e-mail the "English Patent Description," "Preliminary Amendment of Claim," "Declaration and Power of Attorney," and "Deed of Assignment" for the patent application in the United States, as well as the documents necessary for the application in Canada.

Thus, Mr. Ogura's Declaration specifically identifies the instant patent application and the Declaration among those documents that were sent to Mr. Makino.

Second, Exhibit C, the e-mail correspondence between Mr. Ogura and Mr. Makino, shows that copies of the patent application and the Declaration were presented to Mr. Makino for his review and signature. Exhibit C, page 4, lines 3-17 show that the patent application and the Declaration relating to the patent application for "A Method for Glossing Solid Surface and Film-Forming Coating Liquid" were presented to Mr. Makino. Specifically, lines 6 and 8-9 show the attachment of the patent application as a .pdf file, along with the caption "This is an English Patent Description. Please check the contents." Furthermore, lines 13-17 reflect the attachment of the Declaration as a .pdf file, along with the caption "This is a Declaration and Power of Attorney for the patent application in the U.S.A. Please check the contents and place your signature and date on the line below the print name on page 3."

Third, Exhibit A provides evidence that a copy of the patent application was presented to Mr. Makino. Mr. Ogura's Declaration incorporates Exhibit A as a record of the negotiating process between Mr. Makino and Mr. Ogura (Declaration of Mr. Ogura, paragraph 5). Exhibit A states that Mr. Ogura attached the "English Patent Description" and the "Declaration and Power of Attorney" for the patent application in the U.S.A. relating to "A Method for Glossing Solid Surface and Film-Forming Coating Liquid" to an e-mail to Mr. Makino requesting his signature on the documents (English translation of Exhibit A, page 1, lines 14-26).

For these reasons, factual evidence that a copy of the patent application was presented to Mr. Makino is provided in Mr. Ogura's declaration and Exhibits A and C. Accordingly, these documents satisfy the evidentiary requirements of 37 C.F.R. § 1.47(a).

B. The evidence of record shows that Mr. Makino refused to sign *all* of the documents, including the Declaration.

First, Mr. Ogura's Declaration attests that Mr. Makino specifically refused to sign *all* of the documents, including the Declaration:

On May 25, 2006, I received an e-mail reply from Mr. Makino indicating that he refused to sign the necessary documents (Mr. Ogura's Declaration, paragraph 6).

Mr. Makino's refusal, as attested by Mr. Ogura, clearly refers to all of the documents that were sent to him, including the Declaration.

Second, Exhibit C, the e-mail correspondence between Mr. Ogura and Mr. Makino, shows that Mr. Makino refused to sign all of the documents, including the Declaration. Exhibit C is Mr. Makino's reply followed by Mr. Ogura's earlier inquiry. In other words, the e-mail response of Mr. Makino has appended to it Mr. Ogura's inquiry of the same day, as is conventional in many e-mail communications. The embedded dates and times of receipt show the sequence of the communications.

In Exhibit C, Mr. Ogura's e-mail to Mr. Makino specifically requests that Mr. Makino print, review, and sign all of the documents attached to the e-mail, including the attached patent application and the Declaration (Exhibit C, page 2, lines 7-14; page 4, lines 3-17). Exhibit C also includes Mr. Makino's reply to Mr. Ogura's e-mail, clearly refusing to sign anything (English translation of Exhibit C, lines 6-11). Mr. Makino's blanket refusal to sign indicates that he refused to sign all of the documents sent to him, including the Declaration.

Third, Exhibit A, the record of the negotiating process between Mr. Makino and Mr. Ogura, indicates that Mr. Ogura received an e-mail reply from Mr. Makino informing Mr. Ogura that Mr. Makino refused to put his signature on these documents (English translation of Exhibit A, page 2, lines 5-6).

For these reasons, factual evidence that Mr. Makino refused to sign all of the documents presented to him, including the Declaration, is provided in Mr. Ogura's Declaration and Exhibits A and C. Accordingly, these documents satisfy the evidentiary requirements of 37 C.F.R. § 1.47(a).

C. Certification of English Translations

The original Exhibits A-C are in the Japanese language, and the Applicants have provided English translations. The Applicants submit herewith a signed statement from the

individual who provided the English translations of the Exhibits attesting to that individual's competency in Japanese and English, as well as to the validity of the English translations (Exhibit D).

D. Conclusion

For the reasons set forth above, the evidence submitted with the Petition under 37 CFR § 1.47(a), including the Declaration of Mr. Ogura and supporting Exhibits A and C, clearly shows that Mr. Makino was presented with a copy of the instant patent application and that Mr. Makino refused to sign the Declaration.

For these reasons, reconsideration and grant of the Petition is respectfully requested.

Applicants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicants have inadvertently overlooked the need for a petition and fee for extension of time.

If any additional fee is required in connection with this communication, charge Account No. 12-1216.

Respectfully submitted,

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Date: *Apr. 5, 2007*
SML/tbh

CERTIFICATION OF ENGLISH TRANSLATION OF EXHIBITS A-C

This is to certify that Shiro TERASAKI, who is skilled in the Japanese and English languages, translated from Japanese into English the "Record of the Negotiating Process between Mr. Makino and Mr. Ogura" (Exhibit A), Mr. Ogura's e-mail of May 16, 2006 (Exhibit B), Mr. Ogura's e-mail of May 25, 2006 and Mr. Makino's reply of May 25, 2006 (Exhibit C) that were submitted in support of the Petition under 37 CFR § 1.47(a).

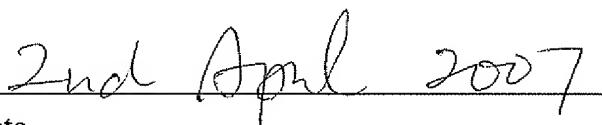
This certifies that the English translations of Exhibits A-C that were submitted with the Petition under 37 CFR § 1.47(a) conform essentially to the original Japanese language.



Signature of Translator

Shiro TERASAKI

Printed Name



Date